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**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

930100-2001

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

In re Application of

Tammik et al.

Application Number

10/507,247

Filed

02-07-2005

For

Composition including a pigment
assembly comprising mica core

Art Unit

1615

Examiner

Mercier, Melissa

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))

\$ 510.00

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:

\$ 255.00

☐ A check in the amount of the fee is enclosed.

☒ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant/inventor.

Howard C. Lee
Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Howard C. Lee
Typed or printed name

☒ attorney or agent of record.
Registration number 48,104

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Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

March 10, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

1. New matter rejection in Final Rejection is a clear error

The applicants' response of 25 October 2007 included the following amendment to the claim 67 (which is the only independent claim currently pending):

67. (Currently amended) A cosmetic and/or therapeutic composition for the topical use in the form of an oil, cream, lotion or paste comprising 2-20% by weight of a pigment assembly in the form of a mica core coated with at least one metal oxide layer and wherein the outermost layer of the pigment assembly is a metal oxide layer which is selected ~~chosen~~ from the group consisting of Fe₂O₃ and a mixture of Fe₂O₃/ TiO₂ and wherein the thickness of the outermost metal oxide layer is 40-80 nm.

Despite pointing the Examiner to the basis for support for the above claim limitations (Figures 6, 7, 8 and 10; page 14, lines 6-10 and page 7, lines 15-17), claims 50-52, 54-58 and 67 were then rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement by introducing new matter. However, this rejection is in error for the following reasons.

First, it is unclear from the final rejection that Figures 6, 7, 8 and 10 were considered and if they were considered, that the entire Figure was considered. Although it could be simply a typographical error, the final rejection only references "Figures 6-7 and 10" (see page 2, 4th line from the bottom of the final rejection).

However, even presuming that each of the figures were considered, the Examiner's subsequent comments suggests that the entirety of the figures was not considered – "The figures demonstrate the UV transmittance measurement of compositions, not the location of the oxide layer and the specification passages additionally do not disclose the location or requirement of the outermost layer being the metal oxide."

Attached to and the end of these arguments are copies of Figures 6, 7, 8 and 10 with the block diagram which shows that the Fe₂O₃ or mixture of Fe₂O₃/TiO₂ coating on the mica core (M) is the outermost layer. While the figures demonstrate the UV transmittance measurement of

compositions, they also how the location of the oxide layer relative to the mica layer (see circled sections from the attached figures).

Likewise, the Examiner was clearly in error in alleging that passages from page 14, lines 6-10:

“The different figure 3-12 shows the different effects that will be obtained using differently constructed pigment assemblies. ***A drawing of the pigment assembly used in each composition is shown underneath each graph***, denoting the thickness of the metal oxide layer covering the mica core, denoted M. The metal oxide layers are denoted using their chemical formula, wherein TiO_2 is titanium dioxide, Fe_2O_3 is iron oxide...” (emphasis added)

and from page 7, lines 15-17:

“Surprisingly, it has been found that the most effective absorption of UV light will take place when the pigment assembly is made from ***a mica core coated with either titanium dioxide or iron oxide***.” (emphasis added)

do support the applicants’ amendment to claim 67.

Given the clear support for the limitation of claim 67 can only speculate that either these source of support were not considered by the Examiner or the Examiner erroneously believed that the exact language of the claim limitation was required to be in the specification itself, i.e. *ipsis verbis* support. (The invention claimed does not have to be claimed in *ipsis verbis* in order to satisfy the description requirement of §112. *In re Lukach*, 442 F.2d 967, 969 (CCPA 1971)(citations omitted). Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *In re Edwards*, 568 F.2d 1349, 1351-1352, 196 USPQ 465, 467 (CCPA 1978).).

Therefore, one of ordinary skill in the art would have been able to ascertain that the applicants had possession of their presently claimed invention based upon the applications as filed.

2. Obviousness rejections was made in error

a. New matter error

As the “outermost layer” limitation was apparently not considered in light of the erroneous new matter rejection discussed above, the obviousness rejections based on the combination of Miyoshi and Kimura are also in error at least in part for failing to describe this

limitation. Even if the Examiner believed that the new matter rejection was proper, the limitations still required consideration and re-establishment of the *prima facie* holding of obviousness (see MPEP 2143.03 (All Claim Limitations Must Be Considered), Section II (Limitations Which Do Not Find Support in the Original Specification Must Be Considered)).

b. Secondary considerations/"routine optimization" error

In addition, the Examiner erred in not considering evidence of secondary considerations, i.e. the thickness of the metal oxide layer results in much lower transmittance (T(%)) than a comparable metal oxide over a wavelength of at least 200-300 nm. For example, compare Figure 7 (iron oxide with a thickness of 40-60 nm) vs. Figure 9 (iron oxide with a thickness of 140-160 nm – which is outside the scope of the applicants' claims). Surprisingly, despite decreasing the thickness of the metal oxide, the level of transmittance decreased by about 70%.

Not only was it in error to overlook this evidence of unexpected results, but it was also in error to attribute these metal oxide thickness ranges to "routine optimization", i.e. there was no support for the Examiner's assertion that thickness was recognized as a results effective variable either from the references themselves or from the knowledge of those within the art. *See MPEP 2144.05, section II*. In addition, the alleged optimization is contrary to what was expected in the art, i.e. decreasing the thickness of the metal oxide would have been thought to increase not decrease the amount of transmittance.

c. Error in factual determination regarding Miyoshi

With respect to the obviousness rejections made over Miyoshi, the fine particles of metal oxide bound by a binding agent to a larger substrate particle is NOT a metal oxide LAYER as defined in claim 67. The metal oxide particles in Miyoshi must have a particle size less than 100 nm in order to be effective against UV rays (see col. 3, lines 21-27 of Miyoshi). As such, one of ordinary skill in the art would find that such small particles of metal oxide are staggered on top of each other and does not constitute a layer of 40-80 nm as claimed by the applicants.

Fig. 6

D

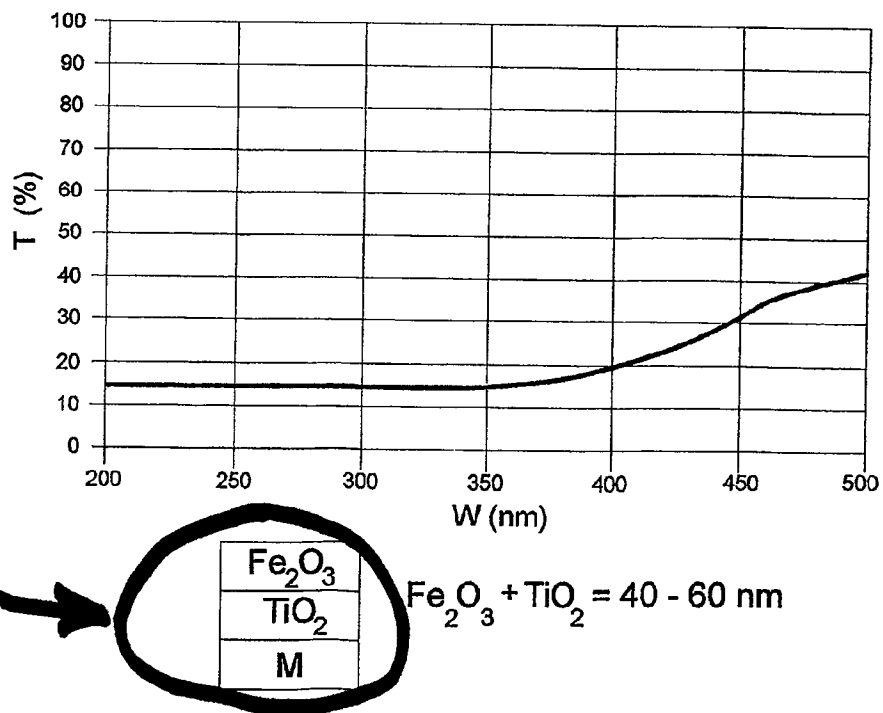


Fig. 7

E

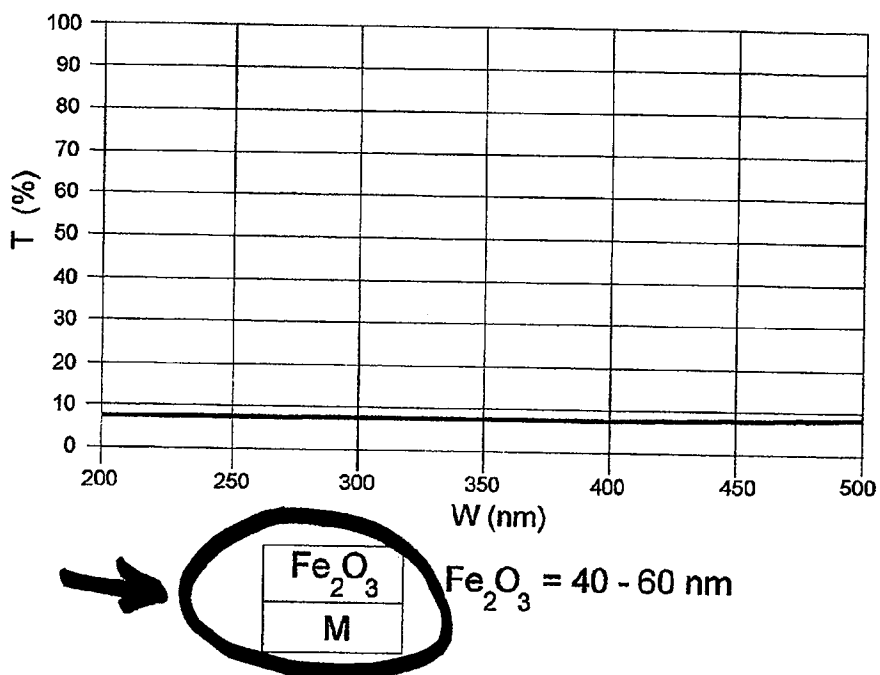


Fig. 8

F

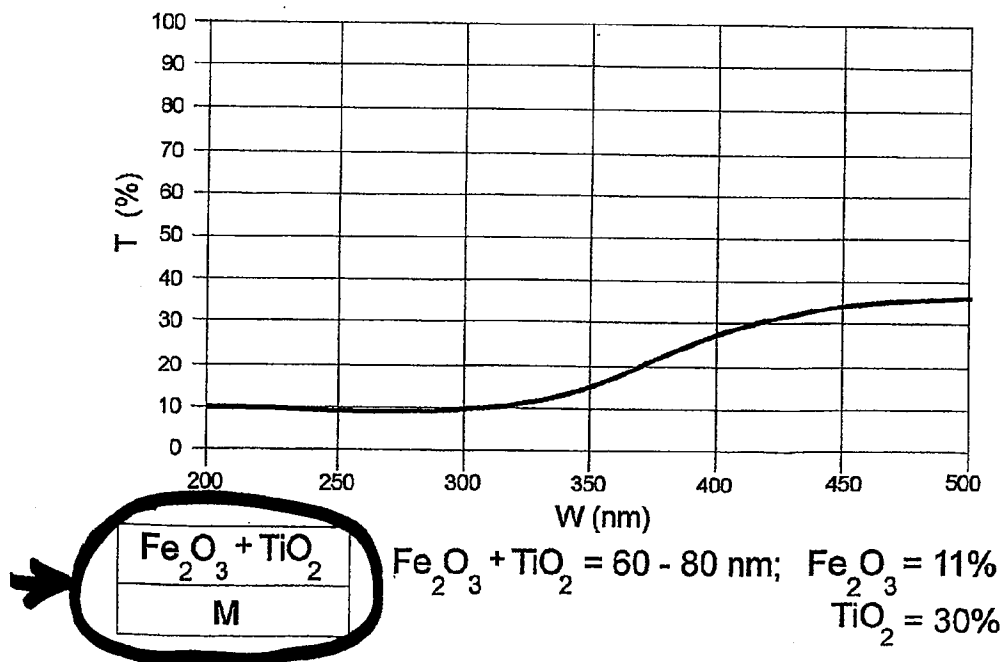


Fig. 10

H

